

REMARKS

Claims 1-3, 9, 14 and 16-31 are currently pending in the application. Claims 1-3, 9, 20-22, 25, and 28 are in independent form.

The Office Action states that claim 20 is objected to because it depends upon a canceled claim. Claim 20 has been amended to be placed in independent form, thereby obviating the present rejection. Reconsideration of the rejection is respectfully requested.

Claims 1, 3, 9, 16-19, 23, 24, 26, 27, and 29-31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Small patent in view of the Olson, Jr., patent.

Reconsideration of the rejection under 35 U.S.C. §103(a) over the Small patent in view of the Olson, Jr. patent, as applied to the claims is also respectfully requested.

It is Hornbook Law that before two or more references may be combined to negative patentability of a claimed invention, at least one of the references must teach or suggest the benefits to be obtained by the combination. This statement of law was first set forth in the landmark case of Ex parte McCullom, 204 O.G. 1346; 1914 C.D. 70. This decision was rendered by Assistant Commissioner Newton upon appeal from the Examiner-in-Chief and dealt with the matter of combination of references. Since then many courts have over the years affirmed this doctrine.

The applicable law was more recently restated by the Court of Appeals for the Federal Circuit in the case of ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572,1577, 221 U.S.P.Q. 929 (Fed. Cir. 1984). In this case the Court stated, on page 933, as follows:

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under Section 103 teachings of references can be combined only if there is some suggestion or incentive to do so. The prior art of record fails to provide any such suggestion or incentive. Accordingly we hold that the court below erred as a matter of law in concluding that the claimed invention would have been obvious to one of ordinary skill in the art under section 103."

This Doctrine was even more recently reaffirmed by the CAFC in Ashland Oil, Inc. v. Delta Resins and Refractories, Inc., et al., 776 F.2d 281,297, 227 U.S.P.Q. 657,667. As stated, the District Court concluded:

"Obviousness, however, cannot be established by combining the teachings of the prior art to produce the claimed invention unless there was some teaching, suggestion, or incentive in this prior art which would have made such a combination appropriate."

The Court cited ACS Hospital Systems, Inc. in support of its ruling. This Doctrine was reaffirmed in In re Deuel, 34 USPQ2d 1210 (Fed. Cir. 1995).

It is respectfully submitted that the Olson, Jr., patent was filed March 12, 2001. The presently pending application was filed in the United States June 16, 2001, but claims priority to Canadian Patent Serial No. 2,312,550, filed June 27, 2000. Accordingly, the Olson, Jr., patent is not prior art for the presently pending claims. Reconsideration of the objection is respectfully requested.

With regard to the Small patent, the Office Action states that the Small patent discloses an assembly having the structure claimed in the presently

pending independent claims including a wear member 13, support structure 11, first passage 20, second passage 18, pin retainer 25, and pin means 22 that extends through the first passage and into the second passage for locking the wear member to the support structure and bearing substantially all of the wear member removal compressive forces during the use of the wear member as shown in Figures 1, 3, and 5. However, when read more specifically, the Small patent discloses a system in which the pin retainer must be fabricated from a malleable metal. That is, it must be “capable of being extended or shaped by beating with a hammer or the pressure of rollers.” The pin retainer must then be physically deformed by hammering during the installation before the pin retainer can retain the pin.

In contradistinction, the presently pending independent claims claim a pin retainer that experiences no deformation during installation. Instead, it is preferred that the pin retainer be made of resilient material but compresses elastically during use when the pin shifts into a load bearing position. The resilient pin retainer can experience elastic deformation but not plastic deformation so that the pin can later be easily unscrewed for tooth replacement. In other words, it is not possible for a material to simultaneously exhibit both malleability and resiliency. The terms malleable and resilient refer to differently-shaped regions of the material's Stress-Strain Response Curve. Resilience is observed in the low stress part of Stress-Strain Curve while malleability occurs at high stresses just before a material breaks. A material exposed to stress

exhibits the property of resilience if it responds by straining (distorting) by an amount that varies linearly or almost linearly with the applied stress, and the strain reverses linearly back to zero as the applied stress is removed. This is also called elastic behavior. A material exposed to stress exhibits the property of malleability if it responds by straining (distorting) by an amount that varies non-linearly with the applied stress, and the strains are permanent, that is, they do not return to zero as the applied stress is removed. This is also called plastic behavior.

The property of resilience is observed for materials stressed into the initial linear portion of the material's Stress- Strain Curve that begins at zero stress and extends at the material's yield stress. As the stress is increased, the strain continues to grow linearly until the material's yield stress is reached. From that point on, for stresses higher than the yield stress, the strains no longer vary linearly with the applied stress. The material experiences large, non-linear strains in response to a small increase in stress and undergo permanent distortion after the stress is removed. This is called malleable behavior. The terms resilient and malleable are therefore not material properties that exist in isolation from the material's environment. They refer to the shape of the material's Stress-Strain Response Curve. A ductile material that exhibits a resilient response to low stresses will exhibit a malleable response to large stresses. A brittle material that exhibits a resilient response to low stresses will break at high stresses without showing any malleability whatsoever. As a result,

these characteristics are independent of each other. Therefore, the resilient pin retainer of the presently pending independent claims is necessarily formed of a non-malleable material because a malleable material would not provide the required elastic deformation. Since the Small patent does not disclose the resilient pin retainer included in the assembly of the presently pending independent claims, the claims are patentable over the Small patent and reconsideration of the rejection is respectfully requested.

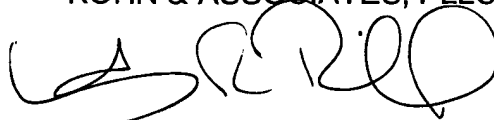
The remaining dependent claims not specifically discussed herein are ultimately dependent upon at least one of the independent claims discussed above. References as applied against these dependent claims do not make up for the deficiencies of those references as discussed above. The prior art references do not disclose the characterizing features of the independent claims discussed above. Hence, it is respectfully submitted that all of the pending claims are patentable over the prior art.

In view of the present amendment and foregoing remarks, reconsideration of the rejections and advancement of the case to issue are respectfully requested.

The Commissioner is authorized to charge any fee or credit any overpayment in connection with this communication to our Deposit Account No. 11-1449.

Respectfully submitted,

KOHN & ASSOCIATES, PLLC



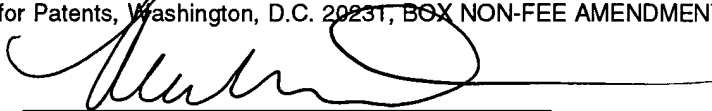
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Dated: January 20, 2004

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